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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055269
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Mango's Tropical Cafe, LLC f/k/a
Mango's Tropical Cafe, Inc.,**
Petitioner,

Cancellation No.: 92055269
Registration No.: 3,328,822
Mark: **TANGO MANGO**
Registration Date: November 6, 2007

v.

Tango Mango, LLC,
Registrant.

**PETITIONER'S REPLY MEMORANDUM OF LAW IN SUPPORT OF ITS MOTION
FOR SUMMARY JUDGMENT AND IN OPPOSITION TO REGISTRANT'S CROSS-
MOTION FOR SUMMARY JUDGMENT**

Petitioner Mango's Tropical Cafe, Inc. (hereinafter "Petitioner") respectfully submits this reply memorandum in support of its pending Motion for Summary Judgment and in opposition to the Cross-Motion for Summary Judgment and Response in Opposition to Petitioner's Motion for Summary Judgment (the "Cross-Motion") filed by Registrant Tango Mango, LLC (hereinafter "Registrant").

I. INTRODUCTION

Registrant's Cross-Motion is rife with contradictions, baseless assumptions and unsupported contentions masquerading as undisputed facts. Registrant fails to identify any genuine issues of material fact that could reasonably prevent the Board from ruling that a likelihood of confusion exists between Petitioner's **MANGO'S** trademarks (hereinafter the "**MANGO'S** Marks," attached to Petitioner's Motion for Summary Judgment as Exhibit B), on the one hand, and Registrant's **TANGO MANGO** mark (hereinafter "Registrant's Mark"), on the other. Throughout its papers, Registrant inappropriately and intentionally mischaracterizes and demeans the nature of Petitioner's successful and longstanding business by, for example,

describing Petitioner's services as "hypesexualized" offered by "scantly clad men and women," apparently on the basis of Registrant's theory that "sex sells." Cross-Motion, pp. 5, 11, 15, 20. Registrant's desperate red herring efforts to distinguish the marks and the parties' respective services are comical, but, as detailed below, wholly unpersuasive. Registrant's Cross-Motion contains absolutely no authority precluding the Board's entry of summary judgment in Petitioner's favor on the issue of likelihood of confusion.

In addition, Registrant's subsequent remedial measures (i.e., assigning the '822 Registration *again* to avoiding a finding of abandonment) are both dilatory and legally insufficient. As discussed below, Registrant's use of "Tango Mango, LLC" in two assignment transactions with an unrelated third party is not a mere "error" or "mistake" that can be cured. Accordingly, Petitioner respectfully submits that the Board may, and should, properly **GRANT** Petitioner's Motion for Summary Judgment and cancel the '822 Registration.

II. PRIORITY AND STANDING

As an initial matter, Registrant claims that Petitioner "fails to establish priority or standing" on the basis that (1) Petitioner "relies exclusively on its registration to establish priority for all of its Marks;" and (2) Petitioner has not demonstrated it will be damaged by the continued registration of Registrant's Mark.

Registrant's first assertion regarding Petitioner's purported "exclusive" reliance on its trademark registrations is a gross mischaracterization of the evidence before the Board and completely ignores the Declaration of Joshua Wallack, attached as Exhibit A to Petitioner's Motion for Summary Judgment. Mr. Wallack's sworn testimony, along with the exhibits thereto, amply demonstrates that Petitioner owns and operates Mango's Tropical Cafe, a renowned South

Beach restaurant and nightclub which has been in continuous operation for over 20 years (since at least as early as March 1991) – and approximately 14 years prior to Registrant’s confusingly similar use of Registrant’s Mark. Mr. Wallack’s Declaration also sets forth the **MANGO’S** Marks, the manner in which the marks are used, and advertising and other customer recognition of the marks. Exhibit A, ¶¶ 3-15. Petitioner has therefore established priority of use of the **MANGO’S** Marks. Registrant cannot simply disregard Mr. Wallack’s declaration because it does not comport with Registrant’s misguided theory that Petitioner lacks priority over Registrant. Additionally, Registrant has not challenged the validity of the **MANGO’S** Marks. *See King Candy Co., Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400 (CCPA 1974) (priority is not an issue where oppose pleads registration the validity of which is unchallenged). Thus, Petitioner’s priority should not be considered in issue.

With respect to Registrant’s assertions regarding Petitioner’s standing, Petitioner alleges that it has (1) a “real interest” in the proceedings; and (2) a reasonable basis for the belief that Petitioner will suffer if the ‘822 Registration is permitted to continue. Motion for Summary Judgment, p. 8. To plead a “real interest,” plaintiff must allege a “direct and personal stake” in the outcome of the proceeding. *See Ritchie v. Simpson*, 50 USPQ2d 1023, 1025-6 (Fed. Cir. 1999); TBMP § 309.03(b). There is no requirement that actual damage be pleaded or proved in order to establish standing or to prevail in a cancellation proceeding. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009) (plaintiff does not have to prove claims or actual damage to establish standing). Rather, the allegations in support of plaintiff’s belief of damage must have a “reasonable basis in fact.” *Ritchie*, 50 USPQ2d at 1027.

A real interest in the proceeding and a reasonable belief of damage may be found, for example, where plaintiff establishes a claim of likelihood of confusion that is not wholly without merit, including claims based upon current ownership of a valid and subsisting registration or prior use of a confusingly similar mark. *See Cunningham*, 55 USPQ2d at 1844; *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 (TTAB 2004) (evidence of ownership of a valid and subsisting registration and assertion of non-frivolous likelihood of confusion claim establishes standing); *see also Nahshin v. Prod. Source Int'l, LLC*, 2013 TTAB LEXIS 312, *14 (TTAB June 21, 2013)(“Petitioner has established, as discussed below, that he is the owner of the mark NIC-OUT; that he has used the mark in the United States through distributors; and, thus, that he is damaged by respondent's involved registration of the virtually identical mark NIC OUT. As such, petitioner has established that he has standing.”)(internal citations omitted); *Baroness Small Estates, Inc. v. America Wine Trade, Inc.*, 2012 TTAB LEXIS 335, *5 (TTAB Sept. 17, 2012)(“Petitioner has made of record several registrations it owns for marks for wine, thus showing that it is in the wine business and is a competitor of respondent's. This is sufficient to establish petitioner's standing.”).

Registrant does not challenge Petitioner's ownership of valid and subsisting (and in certain cases, incontestable) trademark registrations for the **MANGO'S** Marks.¹ In fact, Registrant previously admitted “according to the United States Patent and Trademark Office assignment records [sic] the Petitioner owns the listed registrations:

No. 4,190,731 for the mark MANGO'S

¹ Registrant also concedes the conceptual strength of the term “mango” in **MANGO'S** Marks. In the Cross-Motion, Registrant refers to its own use of “mango” as “arbitrary if not fanciful.” Cross-Motion, p. 20.

No. 4,224,643 for the mark MANGO’S TROPICAL CAFE

No. 3,284,057 for the mark MANGO’S TROPICAL CAFE & Design

No. 3,108,906 for the mark MANGO’S MAMBO BAR & Design

No. 3,700,648 for the mark MANGO’S TROPICAL CAFE & Design

No. 3,512,984 for the mark MANGO’S TROPICAL CAFE & Design

No. 3,649,192 for the mark MANGO’S TROPICAL CAFE & Design[.]”

Registrant’s Answer to First Amended Petition to Cancel, ¶ 1. Instead, Registrant persists that “[t]he pertinent facts belie [Petitioner’s] assertion” regarding its standing in this Cancellation proceeding because “[n]either of Petitioner’s new applications [for **MANGO’S** and **MANGO’S TROPICAL CAFE**] received a refusal due to Registrant’s Mark.” Cross-Motion, p. 7. Registrant previously raised this ill-founded issue in response to Petitioner’s Motion to Amend its Petition to Cancel [Dkt. No. 19] and it was summarily rejected by the Board:

We find respondent’s argument that the addition of these two new registrations to petitioner’s pleading would serve no useful purpose since the USPTO has already found that respondents’ mark is not confusingly similar to the marks subject to the two registrations petitioner now seeks to add to its pleading unpersuasive. **It is well established that the Board must determine each case on its own record and prior decisions by examining attorneys are not binding on the Board.** *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

[Dkt. No. 22] (emphasis added). This argument is still “unpersuasive.” Given that Petitioner has “establish[ed] a claim of likelihood of confusion that is not wholly without merit, including claims based upon current ownership of a valid and subsisting registration [and] prior use of a confusingly similar mark,” *Cunningham*, 55 USPQ2d at 1844, Registrant’s allegations that Petitioner has failed to establish standing are meritless.

III. LIKELIHOOD OF CONFUSION

In its Motion for Summary Judgment, Petitioner amply demonstrates that (1) Petitioner's **MANGO'S** Marks and Registrant's Mark, when compared in their entireties, are significantly similar in appearance, sound, connotation, and commercial impression that there exists a likelihood of confusion among the parties' marks; (2) the parties' respective services are literally and legally identical; (3) the marks are used in connection with services that travel in identical trade channels; (4) the consumers of restaurant services are not particularly sophisticated, thereby increasing the likelihood of confusion; (5) the advertising media employed by the parties is similar; and (6) Registrant demonstrated a willful intent through its intentional blindness when it appropriated Petitioner's **MANGO'S** Marks.

In its Cross-Motion, Registrant argues four overlapping theories against a finding of likelihood of confusion between the parties' respective marks. First, Registrant claims that Registrant's Mark and the **MANGO's** Marks differ in sound, appearance and commercial impression. Second, Registrant argues that the parties' respective restaurant services and channels of trade are "dissimilar" and "prevent a likelihood of confusion." Third, Registrant inexplicably claims that the parties' relevant customers are sophisticated. Finally, Registrant claims that the common term "MANGO" is sufficiently weak, based on purported third-party use, that consumers look to other parts of the mark to distinguish the source of the parties' respective services. For the reasons set forth in Petitioner's Motion for Summary Judgment and below, Petitioner submits that none of Registrant's erroneous arguments and mischaracterizations is sufficient to avoid a finding of likelihood of confusion.

A. The Marks are Very Similar in Appearance, Sound, Commercial Impression and Meaning

Preliminarily, Petitioner and Registrant use their respective marks in connection with services that are legally identical, and where this is the case, the similarity between the marks necessary to support a determination that confusion is likely declines. *See Bridgestone Am. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1337, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). In its Cross-Motion, Registrant argues that the marks are sufficiently different in appearance, sound, commercial impression and meaning to avoid a likelihood of confusion.² Registrant bases this argument on Petitioner's inclusion of the disclaimed wording "tropical cafe" or "mambo bar" in registrations for certain of the **MANGO'S** Mark.³ Registrant, however,

² Registrant's Cross-Motion also includes a section regarding "goods typically purchased in a visual or self-service manner where the purchaser sees the goods being bought." This argument is irrelevant. As discussed below, both Petitioner and Registrant offer *restaurant services*.

³ As explained in Petitioner's Motion for Summary Judgment, weaker descriptive terms, such as "bar" or "cafe" have little or no source-indicating significance because they describe the services. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). Thus, there is a substantial evidence to support a finding that the dominant portion of the parties' respective marks is "MANGO" (or "MANGO'S") and the Registrant's Mark is similar to the **MANGO'S** Marks. Moreover, given that "restaurants are often recommended by word of mouth and referred to orally," the shared use of "MANGO" (or "MANGO'S") substantially increases the likelihood of confusion. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997); *see also In re Heartland Design Assocs., LLC*, 2009 TTAB LEXIS 34 (TTAB Jan. 13, 2009) ("Moreover, restaurants are often recommended by word of mouth."); *Marshall Field & Co. v. Mrs. Field's Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992) ("[C]ompanies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward's for Montgomery Ward's, and Bloomies for Bloomingdales."). To that end, Registrant's contention that its use of "tango" obviates any confusion is simply without merit. Cross-Motion, p. 10-11.

concedes that Petitioner owns a trademark registration for the word mark **MANGO’S**, which contains no additional wording or design elements.

1) Registrant’s Irrelevant Translation and Alternative Definition of “MANGO”

In an attempt to distinguish Registrant’s Mark from the **MANGO’S** Marks, Registrant adopts the position that the “Spanish” term “mango” is slang for “very sexy man.” Cross-Motion, pp. 5, 11, 12, 14. In support of this odd position, Registrant attaches webpages from the “Alternative Spanish Dictionary,” a website purportedly built by “Nelson_G,” on Tripod, a free website service. *Id.*, Exhibit 10. The top of this website states that “[m]any of these terms have meanings other than the one listed here, [sic] please refer to a Spanish dictionary to consult the proper definition.” *Id.* The website also defines “mango” as follows: “very sexy man (Mex. Spanish); This term actually refers to the enticing taste of the tropical fruit.” *Id.* From this user-generated definition, Registrant surmises that “[t]he slang meaning for ‘mango’ is ‘very sexy man.’” Cross-Motion, pp. 5, 11, 12, 14. Registrant subsequently requests that the Board “take judicial notice of this fact as it is a definition, and capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.” *Id.*, p. 5, fn. 2. Notwithstanding the complete irrelevance of this particular analysis of the issues at hand, Petitioner disagrees with the assertion that the Board may take judicial notice of the “Alternative Spanish Dictionary.”

Petitioner notes the Board’s authority to take judicial definitions, “including online dictionaries *which exist in printed format.*” *Fontaine v. Light My Fire, AB*, 2012 TTAB LEXIS

12, *9 n. 3 (TTAB Jan. 12, 2012), citing *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002)(emphasis added). Registrant’s purported “dictionary” definition, however, inherently lacks the requisite element of trustworthiness. See *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006)(“We do not, however, take judicial notice of definition no. 7, which is excerpted from www.wordsmyth.net. The source of the definition quoted at the website is not identified on the submitted website excerpt or by the examining attorney and, thus, we can not verify it or determine its reliability.”); see also *In re Pro-Tek Chem., Inc.*, 2013 TTAB LEXIS 119, *3 (TTAB Mar. 15, 2013)(“Further, the Board will not take judicial notice of entries from Wikipedia. See *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007), for discussion of the reliability of statements made in Wikipedia entries. Accordingly, we will not consider the evidence.”).

Additionally, Registrant does not explain why the English term “mango” should be translated from Spanish (or any other language). “Mango” is not “a word taken from a well-known foreign modern language.” TMEP § 1210.10. The doctrine of foreign equivalents should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). “The “ordinary American purchaser” in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language....[defining “ordinary American purchaser” as the “average American buyer”] would write the doctrine out of existence” *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006). The “ordinary American purchaser” includes “all American purchasers, including those proficient in a non-English language who would

ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009). Here, Registrant does not claim that “mango” is primarily considered a Spanish term requiring translation, nor is this position supported by the facts. Thus, the Board should not give any consideration to Registrant’s purported evidence that “[t]he slang meaning for ‘mango’ is a ‘very sexy man’” or its arguments that Petitioner’s **MANGO’S** Marks “suggest[] that the services offered are owned by a sexy person.” Cross-Motion, pp. 5, 11, 12, 14. Of note, Petitioner also wishes to point out that both parties obviously use the term “MANGO” as the dominant portion of their marks, as detailed herein, so any perceived alternative definition that Registrant seeks to attach to Petitioner’s use of “MANGO” would equally apply to Registrant’s use of the identical term.

2) Registrant’s Analysis of “TANGO”

Registrant also describes the connotation of “tango” in Registrant’s Mark as “a ‘dance’ or complex flavor to the food.” Cross-Motion, pp. 10, 14 (“the Registrant’s Mark connotes somewhere fun, easy and cute with foods that would otherwise make your taste buds ‘dance.’”). Registrant maintains that Petitioner’s view of “tango” as a “passionate Latin dance” is “too simplistic.” *Id.*, p. 10. In a seemingly-contradictory fashion, Registrant then argues that Petitioner’s inclusion of “mambo” in its **MANGO’S MAMBO BAR** trademark “suggest[s] a bar or nightlife where dancing is a prominent feature.” Cross-Motion, p. 13. Given that both the Mambo and Tango are undisputedly Latin ballroom dances,⁴ Registrant’s argument that the marks have a dissimilar connotation or commercial impression is disingenuous. If Petitioner’s

⁴ True and correct copies of the definition excerpts for “mambo” and “tango” from Merriam-Webster are attached as Composite Exhibit A.

use of “mambo” suggests “dancing [as] a prominent feature,” the same should be held true for Registrant’s use of “tango.”

3) Registrant’s Analysis of Design Elements in MANGO’S Marks

Finally, as to Petitioner’s “design element of a parrot with a palm tree,” Registrant describes the logo design as that of a “tropical nature.” Cross-Motion p. 12. Again, Registrant does nothing to distinguish this “tropical nature” from the “bright, colorful, and playful atmosphere” allegedly created by Registrant and its use of Registrant’s Mark. *Id.*, pp. 3, 10. Indeed, Petitioner similarly views the “tropical nature” of its logo design and use of its **MANGO’S Marks** as “bright, colorful, and playful.” *Id.* Considering the marks in their entirety, it is readily apparent that Registrant’s Mark combines elements of the **MANGO’S Marks** such that the parties’ respective restaurant services appear to emanate from the same source or origin.

Based on Registrant’s appropriation of the most distinctive and dominant portion of the **MANGO’S Marks**, the visual and phonetic similarities between the marks, and the shared “bright, colorful, and playful” connotation, Registrant’s Mark is confusingly similar to the **MANGO’S Marks**.

B. The Parties' Respective Restaurant Services are Legally Identical and Travel in Identical Trade Channels

Registrant focuses much of its Cross-Motion attempting to differentiate the restaurant services offered by Petitioner and Registrant.⁵ Such efforts are futile. Not only is this conclusion without any support, it also wholly ignores that the services identified in the applicable registrations are legally identical. Thus, for the purposes of the determination of a likelihood of confusion, this portion of Registrant's Cross-Motion is irrelevant. *See Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009) *aff'd* 415 Fed. Appx. 222 (Fed. Cir. 2010) ("The services are legally identical. Defendant has registered its mark and is seeking to register its word and design marks for "restaurant services, namely, eat-in and take-out coal oven pizza and other items" and plaintiff has registered its marks for restaurant services.").

Likewise, because the services identified in the registrations are legally identical, the Board must presume that the channels of trade and classes of purchasers are the same. *See Fogo De Chao Churrascaria (Holdings) LLP v. Fogo E Brasa, L.L.C.*, 2009 TTAB LEXIS 283, *9-10 (TTAB Apr. 20, 2009) ("Accordingly, the trade channels must be construed to include single location restaurants, both formal and casual, as well as outlets in food courts or other locations in which multiple purveyors of restaurant services are present. And as a result, we must consider the classes of customers to include all members of the general public, including those in search of formal dining options, and those seeking more casual options."); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"). Thus, the parties' identical services and trade channels favor a finding of likelihood of confusion. **The Relevant Consumers are NOT Sophisticated**

⁵ Registrant also attempts to redirect the Board's focus to Petitioner's nightclub services. Cross-Motion, p. 17 ("As addressed *supra*, the Petitioner's primary services are for nightclubs."). This baseless assumption is both irrelevant and inaccurate.

Without any support, Registrant concludes that the consuming public “is very conscious of where they are going,” and thus “would be careful in choosing their location and would pay attention to the marks related to the venue to make sure they were going to the ‘right’ one.” Cross-Motion, pp. 17-18. Registrant ignores prior Board decisions that consumers of restaurant services are not particularly sophisticated. *See Papa-n-Son's, LLC v. Pie Town Pizza, Inc.*, 2009 TTAB LEXIS 427, *12 (TTAB June 2, 2009)(“Inasmuch as restaurant services encompass the sale of inexpensive foods..., and inasmuch as restaurant services are a type of service widely and commonly used by many consumers, we construe the services of both parties to be available to the same class of consumers, namely, any member of the general public looking for a restaurant meal, whether of the eat-in or carry-out kind. These are not typically services in connection with which consumers exercise a high degree of care in making their purchasing decisions.”)(*citing Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000)); *Fogo*, 2009 TTAB LEXIS 283 at *11 (“[A]pplicant’s argument that the restaurant services are not fast food restaurants and that the atmosphere and actual cost of the services results in consumers exercising care in selecting a restaurant is legally irrelevant.”).

As both Petitioner and Registrant offer restaurant services with a similar relatively low price point, this factor favors Petitioner and a finding of likelihood of confusion.

C. The Number and Nature of Similar Marks Used on Similar Goods and Services are Insufficient to Prevent a Finding That Consumers are Likely to be Confused

Registrant’s Cross-Motion also focuses on Registrant’s specious assertion that “the term MANGO enjoys widespread and significant use by third parties.” Cross-Motion, p. 19. In

support of this position, Registrant attaches information printed from the PTO's Trademark Electronic Search System ("TESS") for nineteen (19) registrations and pending applications that contain the term "MANGO" (*see* Ex. 2, Cross-Motion), as well as miscellaneous webpage printouts (many of which are illegible) for restaurants purportedly operating under a name that contains the term "MANGO" (*see* Ex. 3, Cross-Motion). This alleged "evidence" of third party use is woefully deficient and fails to support Registrant's position on the strength of the **MANGO'S** Marks.

First, it is well-settled that third-party trademark registrations (which are not even attached to the Cross-Motion) "are not evidence that the marks depicted therein are in use or that the public is aware of them, and thus they are of little probative value." *In re MobileAria, Inc.*, 2004 TTAB LEXIS 161, *16 (TTAB Mar. 16, 2004); *see also In re Fourth Wall Rests., LLC*, 2012 TTAB LEXIS 330, *17 (TTAB Aug. 29, 2012) ("Assuming the business names shown in the Dun & Bradstreet report evidence use of 'Hurricane,' their probative value is limited because they do not show the public's awareness of the respective businesses, and fall far short of the persuasive evidence of 'numerous' third party uses such as those involved in *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1479 (TTAB 1987); and *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560-62 (TTAB 1996), cited by applicant.") (*citing Anthony's*, 95 USPQ2d at 1278); *In re Phillips*, 2010 TTAB LEXIS 215, *15 (TTAB May 26, 2010) ("[I]t is settled that third-party registrations of marks are not in themselves probative evidence of actual third-party use of those marks in the marketplace, for purposes of the sixth *du Pont* likelihood of confusion factor.") (*citing Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992)) ("As to strength of a mark, however, registration evidence may not be

given any weight."); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009)); *Kraft Foods Global Brands LLC v. Brown*, 2009 TTAB LEXIS 569, *7 (TTAB Aug. 20, 2009).

In the instant case, Registrant's "evidence" of the "widespread and significant use of MANGO for restaurant services" is an exaggeration of the extent of the purported third-party use. Specifically, over half of the marks (i.e., at least ten of the nineteen) identified in Exhibit 2 to Registrant's Cross-Motion are registered for goods and services wholly unrelated to restaurant services. For example, Registrant points to MANGO LANGUAGES and Design, Reg. No. 3,560,833, which is registered in connection with "language instruction," in International Class 41, and MANGO MOON PRODUCTIONS, Reg. No. 2,238,514, which is registered in connection with "television program production and distribution; motion picture film production and distribution; and multimedia entertainment software production," in International Class 41. Thus, none of these particular third party uses are even remotely relevant. *See* TMEP §1207.01(a)(i) ("If the goods or services in question are not related or marketed in such a way that they would be encountered by the same person in situations that would create the incorrect assumption that they originate from the same source, then even if the marks are identical, confusion is not likely."). Furthermore, at least with respect to the registrations and pending applications for restaurant and catering services, Registrant has introduced no credible evidence as to current use, scope of use, or whether there is concurrent use in any market such that consumers are conditioned to ignore the common term "MANGO" (or "MANGO'S").⁶

⁶ Additionally, Registrant included TESS information for the mark MANGO MANGO'S CARIBBEAN GRILL & BAR and Design, Reg. No. 4,025,329, which is the subject of Cancellation Proceeding No. 92055268, initiated by Petitioner on March 3, 2012.

Registrant's feeble attempts to create issues of material fact in an effort to avoid the entry of summary judgment should simply be disregarded.

With respect to the webpages submitted by Registrant, such evidence again does not establish that the marks are in use, that the establishments are open and operating, the extent of such use, or again, that the use overlaps such that consumers are conditioned to distinguish any particular restaurant based on slight differences in the marks. Registrant has simply failed to make any submission regarding the actual use of any of the purported third-party uses of "MANGO." *Anthony's*, 2009 TTAB LEXIS 718, *23-25. As such, any third-party use submitted by Registrant in support of an argument that the MANGO'S Marks are weak in scope has absolutely zero probative value in this case.

In addition to the quality of third-party evidence, the quantity of references identified in the Cross-Motion is "far short of the 'more than 575 entities whose names contain the term BROADWAY and which offer restaurant services and/or related services or goods.'" *In re Fulltone Musical Prods.*, 2008 TTAB LEXIS 170, *14 (TTAB Sept. 16, 2008)(citing *In re Broadway Chicken*, 38 USPQ2d at 1562). Indeed, the evidence of record in this case is only a "shadow of the evidence that convinced the Board that confusion was not likely in the *Broadway Chicken* case." *Health Quest of Farmington*, 2003 TTAB LEXIS 331, *11-12 (TTAB 2003). The evidence of the number of restaurants which including the common term "MANGO" (or "MANGO'S"), to the extent admissible, includes a much smaller number of potential third-party uses. This stands in stark contrast to the evidence submitted in *Broadway Chicken*.⁷ Moreover,

⁷ Furthermore, the Board indicated that its *Broadway Chicken* decision was partly based upon the fact that the term "Broadway" is geographically descriptive, which determination further

the evidence, even if admissible, does not indicate or establish that there is any overlap between the markets where the **MANGO'S** Marks have been used.

As initially identified in Petitioner's Motion for Summary Judgment, a search of the Trademark Office's electronic records disclosed twenty-one (21) live registrations and pending applications for marks containing the term MANGO (or derivatives thereof) in connection with restaurant services in Class 43. *See Exhibit F*, Petitioner's Motion for Summary Judgment. Of these references, Petitioner owns four (4) registrations for **MANGO'S**, **MANGO'S TROPICAL CAFE**, and **MANGO'S MAMBO BAR** and Registrant owns one registration. With respect to the remaining sixteen citations, Petitioner has sought cancellation, is opposing the pending application(s), has entered into a coexistence agreement with the registrant and/or is presently investigating the current use of these marks. *See* Petitioner's Motion for Summary Judgment, pp. 17-18.

Registrant's alleged evidence, to the extent even relevant or valid, is underwhelming in comparison with the "500 entities" identified in *Broadway Chicken*. As detailed above, Registrant has introduced no evidence as to the use, scope of use, or whether there is concurrent use in any market such that consumers are conditioned to ignore the common term "MANGO"

weakened the common term. Here, it is undisputed that MANGO'S is not a geographically or otherwise descriptive term. Finally, the Board recognized that "this is a very close case." Given the many distinguishing features, *Broadway Chicken* is not dispositive of this matter. *See also In re Aladdin's Eatery, Inc.*, 2006 TTAB LEXIS 412, *24 (TTAB 2006)(fewer third party uses, not reaching the hundreds as in *In re Broadway Chicken*, and the term "Aladdin" has no geographical significance); *In re CC's Bakeries, Inc.*, 2005 TTAB LEXIS 435, *12 (TTAB 2005)(the third party uses appeared to be local in nature and even if this factor weighed in favor of finding no likelihood of confusion, this one factor is "far outweighed" by the other factors weighing in favor of finding a likelihood of confusion); *Health Quest*, 2003 TTAB LEXIS 331, *11-12 (the fact that no evidence was submitted as to the extent of use of the marks and that the restaurants appear to be small and local in nature support a finding of likelihood of confusion).

(or “MANGO’S”). There is nothing to determine whether there are multiple “MANGO’S” restaurants in the same trading area so that consumers are likely to encounter overlapping uses of “MANGO’S. *Anthony’s*, 2009 TTAB LEXIS 718, *23-25. Moreover, with respect to the webpages submitted by Registrant, such evidence again does not establish that the marks are in use, that the establishments are open and operating, the extent of such use, or again, that the use overlaps such that consumers are conditioned to distinguish any particular restaurant based on slight differences in the marks. Registrant has simply failed to make any submission regarding the actual use of any of the purported third-party uses of “MANGO.”

In light of the above, there is no genuine issue of material fact that the relatively small number of third-party registrations or uses in commerce of other marks is insufficient to prevent a finding that consumers are likely to be confused. This factor weighs in favor of Petitioner.

D. Petitioner has Actively and Adequately Policed the MANGO’S Marks

In the Cross-Motion, Registrant surmises that the **MANGO’S** Marks are weak based on Petitioner’s only “recent ‘gun blazing’ efforts.” Cross-Motion, p. 7. Registrant’s inference is unsupportable and purely speculative.

With respect to the necessary level of enforcement by a trademark owner, “absolute control is not only **not required**, but the Board has recognized that absolute control would be **impossible**.” *Swiss Watch Int’l, Inc. v. Fed’n of the Swiss Watch Indus.*, 2012 TTAB LEXIS 3, 30 (TTAB Jan. 30, 2012)(finding that the respondent’s control “adequate” based on its extensive monitoring and enforcement system, bringing numerous oppositions in the United States and negotiating the abandonment or withdrawal of numerous applications)(emphasis added); *see also Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1888 (TTAB 2006)(“The statute

does not define ‘control’ or indicate the degree of control required, but it is clear that absolute control would be impracticable, if not impossible... "[T]he mere fact of misuse ... is not sufficient to raise an inference that the control was not adequate or that [the mark] has lost all significance as a mark. Even if control is not maintained and misuse occurs, it must be shown that the misuse was of such significance to permit an inference that the mark is generic.").

Petitioner described a sampling of its monitoring and enforcement efforts in its Motion for Summary Judgment. For example, Petitioner has initiated the following trademark cancellation and opposition proceedings:

- *Mango’s Tropical Cafe, Inc. v. Bella Italian Foods, Inc.*, Proceeding No. 92032775 (October 3, 2001);
- *Mango’s Tropical Cafe, Inc. v. W J Phelan, Inc.*, Proceeding No. 92032488 (October 3, 2001);
- *Mango’s Tropical Cafe, Inc. v. Multi-Culture Food Inc.*, Proceeding No. 91165693 (June 28, 2005);
- *Mango’s Tropical Cafe, Inc. v. Borrego*, Proceeding No. 92055164 (February 13, 2012);
- *Mango’s Tropical Cafe, Inc. v. Salem*, Proceeding Nos. 92055309 and 92055284 (March 3, 2012);
- *Mango’s Tropical Cafe, Inc. v. The Mango Room, LLC*, Proceeding No. 92055281 (March 3, 2012);
- *Mango’s Tropical Cafe, Inc. v. Paradise Restaurant Group, Inc. Of St. Augustine*, Proceeding No. 92055268 (March 3, 2012);
- *Mango’s Tropical Cafe, Inc. v. Arga Operadora, S.A. de C.V.*, Proceeding No. 91208672 (January 2, 2013).

See Petitioner’s Motion for Summary Judgment, pp. 17-18.

Given that Registrant has not alleged, as it would be unavailing, that any purported misuse of the **MANGO’S** Marks “was of such significance to permit an inference that the mark[s] [are] generic,” Registrant’s argument that the **MANGO’S** Marks are weak is disingenuous. *Tea Board of India*, 80 USPQ2d at 1888. The **MANGO’S** Marks are entitled to

the scope of protection usually afforded to inherently distinctive marks. *See Team Air Express*, 2007 TTAB LEXIS 110 at *11. This factor favors Petitioner.

Given that no genuine issue of material fact exists in connection with the likelihood of confusion analysis, Petitioner respectfully requests that the Board enter summary judgment in its favor.

IV. ABANDONMENT OF REGISTRANT’S MARK

Finally, Registrant argues that its two intervening, invalid assignments from and to the non-existent “TANGO MANGO, LLC,” and the resultant loss of goodwill⁸ and priority, were merely “mistakes” and “errors” and do not result in the abandonment of Registrant’s Mark. This is not merely a matter of a “misidentification” or a curable defect. Registrant did not simply identify an applicant that did not exist on the filing date when filing its trademark application. *See* TMEP § 1201.02(c). The ‘822 Registration was not assigned by a “person,” within the meaning of the Lanham Act. In addition, Tango Mango, Inc., Knightspin, LLC and “TANGO MANGO, LLC” are not the same, single commercial enterprise, thus any substitution among them as the alleged proper owner would be impermissible.⁹

⁸ Registrant baldly asserts that “Registrant’s Mark was always used in a controlled manner and only by two different parties.” Cross-Motion, p. 24. Registrant provides absolutely no evidence, however, to support this conclusory allegation.

⁹ *Cf. Argo & Company, Inc. v. Springer, et al*, 198 USPQ 626 (TTAB 1978)(the Board found that the application had been filed by the proper person, i.e., by the commercial enterprise comprised of the three individuals, and that their misidentification of themselves in the application as a corporation was a curable defect. The individuals and the non-existent corporation were found not to be different persons, but the same, single commercial enterprise.).

Registrant relies on its recent “corrective assignment” for the ‘822 Registration, recorded on November 6, 2013 after the filing of Petitioner’s Motion for Summary Judgment, to reflect ownership by “Tango Mango, Inc.,” the purported original applicant of Registrant’s Mark. Registrant’s subsequent remedial measures, however, are insufficient to avoid a finding of abandonment of Registrant’s Mark. For one thing, the “corrective assignment” is from Knightspin, LLC, which only allegedly received its ownership of the ‘822 Registration through an assignment from Tango Mango, LLC, an entity that admittedly does not exist and, in fact, has never existed, and never owned by the ‘822 Registration. “TANGO MANGO, LLC” cannot possibly be using the mark for which registration has been obtained. Accordingly, Registrant’s invalid cross-assignments have caused Registrant’s Mark to lose any significance as an indicator of source and should be cancelled by the Board.

V. CONCLUSION

For all of the foregoing reasons, as well as the reasons set forth in Petitioner’s opening brief, the Board should **GRANT** Petitioner’s Motion for Summary Judgment.

Date: December 16, 2013

Respectfully submitted,

FRIEDLAND VINING, P.A.

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*Counsel for Petitioner Mango's Tropical
Cafe, Inc.*

CERTIFICATE OF SERVICE

WE HEREBY CERTIFY that the foregoing **PETITIONER'S REPLY MEMORANDUM OF LAW IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT AND IN OPPOSITION TO REGISTRANT'S CROSS-MOTION FOR SUMMARY JUDGMENT** was served upon the Registrant by delivering true and correct electronic copies of same to Registrant through its counsel on December 16, 2013 as follows:

Rebecca J. Stempien Coyle, Esq.
Levy & Grandinetti
P.O. Box 18385
Washington, D.C. 20036
mail@levygrandinetti.com

/s/Jaime Rich Vining _____
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mam·bo *noun* \ˈmäm-(,)bō\

: a lively dance originally from Cuba

: the music for the mambo

plural **mambos**

Full Definition of MAMBO

g+1

: a ballroom dance of Cuban origin that resembles the rumba and the cha-cha; *also* : the music for this dance

— **mambo** *intransitive verb*

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Examples of MAMBO

They learned to dance the *mambo*.

The band played a *mambo*.

Origin of MAMBO

American Spanish

First Known Use: 1948

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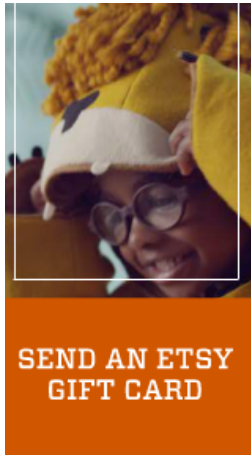
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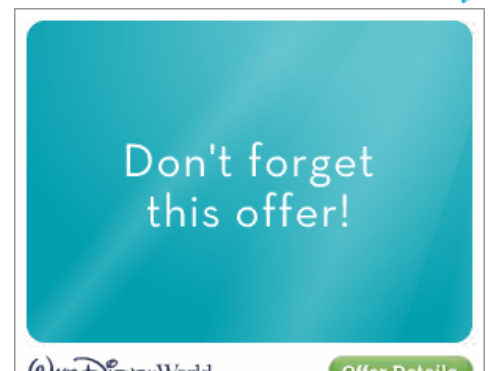
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¹tan·go *noun* \ˈtɑŋ-(,)gō\

: a Latin-American dance in which couples make long pauses in difficult positions; *also* : the music used for this dance

plural **tangos**

Full Definition of TANGO

Like

- 1** : a ballroom dance of Latin-American origin in $\frac{2}{4}$ time with a basic pattern of step-step-step-step-close and characterized by long pauses and stylized body positions; *also* : the music for this dance
- 2** : interaction marked by a lack of straightforwardness <the suspect's *tango* with police>

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Examples of TANGO

The band played a *tango*.

Origin of TANGO

American Spanish

First Known Use: 1913

²tango *intransitive verb*

: to dance the tango

Full Definition of TANGO

: to dance the tango

Examples of TANGO



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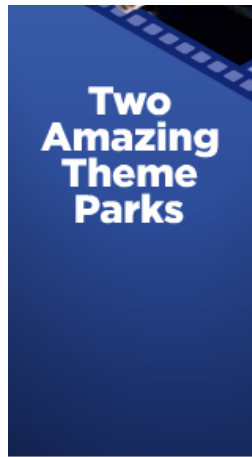
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He's trying to learn how to *tango*.

First Known Use of TANGO

1913

Tango

Definition of TANGO

—a communications code word for the letter *t*

First Known Use of TANGO

1952

tango *noun* (*Concise Encyclopedia*)



Tango danced by Rudolph Valentino and partner from the motion picture *Four Horsemen of the Apocalypse*. Courtesy of Metro-Goldwyn-Mayer Inc., © 1921; photograph from the Museum of Modern Art Film Stills Archive

Spirited dance; also a South American **BALLROOM DANCE**. It evolved in the dance halls and, perhaps, the brothels of poorer districts of Buenos Aires, Arg., possibly influenced by the Cuban habanera. It was made popular in the U.S. by **VERNON AND IRENE CASTLE**, and by 1915 it was being

danced throughout Europe. Early versions, danced to music in the prevailing duple metre (*2/4*), were fast and exuberant; these were later modified to the smoother ballroom step, characterized by long pauses and stylized body positions and danced to music usually in *3/4* time. Among those associated with tango are Juan D'Arienzo, Anibal Troilo, Osvaldo Pugliese, Carlos Di Sarli, Francisco Canaro, **ASTOR Piazzolla**, and Carlos Gardel.

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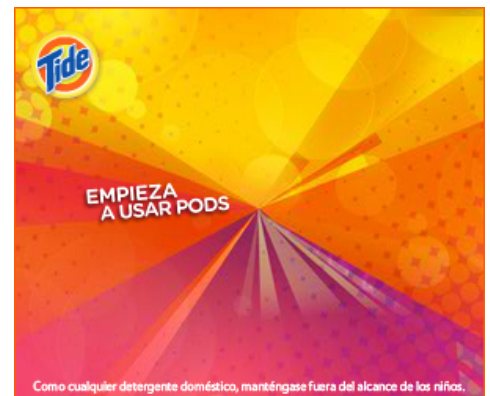
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